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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,201	09/08/2003	Valerie De La Poterie	230172US0	7480
22850	7590	05/30/2008	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			VENKAT, JYOTHSNA A	
ART UNIT	PAPER NUMBER			
			1615	
NOTIFICATION DATE		DELIVERY MODE		
05/30/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/656,201	<b>Applicant(s)</b> DE LA POTERIE ET AL.
	<b>Examiner</b> JYOTHSNA A. VENKAT	<b>Art Unit</b> 1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on **28 February 2008**.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) **36-44 and 50-65** is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) **36-44 and 50-65** is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/1449)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

Receipt is acknowledged of remarks, certified foreign translated document and terminal disclaimer submitted on 2/28/08. In view of certified foreign translated document, 102 (e) rejections over PGPUB documents are hereby withdrawn. In view of terminal disclaimer, the obviousness type double patenting rejection over co-pending application 10/656,278 is hereby withdrawn. In view of new art, prosecution is resumed and the withdrawn claims are not rejoined.

Claims 36-44 and 50-65 are pending in the claims and the generic claims will be examined to the extent that it reads on Kester wax (also known as synthetic bees wax) as the structuring agent.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 36-44 and 50-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent 5,985,298 ('298).

Patent '298 teaches cosmetic compositions. See col.5, ll 41-65 for mascara compositions and these compositions have wax. The waxes include Kester wax, which is also known as synthetic bees wax. The compositions have wax, volatile solvent and non-volatile oil and film former. See also col.6, line 50 through col.7, line 32. See all the examples. The combination of volatile oil and non volatile solvent belongs to claimed fatty phase. See col.2, line 20 through col.4, line 21 for fatty phase. See col4, ll 22-24 for the various cosmetic products.

The weight percent of wax claimed is within the weight percent taught by patent. Example 2 has bees wax and synthetic wax instead of synthetic bees wax. The example drawn to mascara has water (solvent). Patent also teaches other cosmetic compositions and this has ethyl alcohol (claims 53-55). The weight percent of the solvent is also within the claimed range. Mascara composition has film former, which is polyethylene. Patent also teaches film formers at paragraph bridging col.s 5-6 and teaches that various film formers disclosed in CTFA handbook can be used. Patent teaches cellulose derivatives and this belongs to claimed cellulosic polymers. The weight percent of film former disclosed in the patent is within the claimed film former range. Examples have colorant cosmetic additives, colorants.

Accordingly, it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of patent '298 and substitute synthetic bees was for bees wax or synthetic wax taught in the mascara compositions . One of ordinary skill in the art

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would substitute the functional equivalents expecting that the synthetic bees wax can also be used in composition. With respect to limitation claimed in claims 36-38, 43-44 and 50-51 patent office is not equipped to measure tack value, solids content, hardness measurement, consistency index discussed at pages 29-33 of the specification. All these measurement have protocols. This is a *prima facie* case of obviousness.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /  
Primary Examiner, Art Unit 1615